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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/414,121

10/08/1999

SCOTT A. STEELE

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04/30/2004

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/414,121

Applicant(s)

STEEL ET AL.

Examiner

Raquel Alvarez

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,11-13,15-17,19,22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,11-12,13,15-17,19,22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 5-8, 11-12, 13, 15-17, 19 and 22 drawn to determining whether an advertisement have been delivered; and terminating advertisements upon reaching the quota, classified in class 705, subclass 14.
 - II. Claim 27, drawn to a method for providing advertisements based upon the status of sensors in a vehicle, classified in class 701, subclass 1.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as providing advertisement based upon reaching a quota without the status of sensors in a vehicle. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Brina Mancini on 4/22/04 a provisional election was made without traverse to prosecute the invention of group I, claims 1, 2, 5-

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8, 11-12, 13, 15-17, 19 and 22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 27 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1- 2, 5-8, 11-13, 15-17, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al.(6,183,366 hereinafter Goldberg) in view of Hall (6,026,375 hereinafter Hall).

In regard to claims 1, 2 and 12 Goldberg teaches providing services in a communication network(Abstract).

Providing a plurality of service options to an end user of a communication device (see figures 8A-8B); providing products or services to said end user in response to a

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subscription to one of the services options (i.e the user receives Internet services once registered with the Internet provider)(col. 29, lines 7-20); providing advertisements to the end user in lieu of receiving compensation for a subscription (col. 29, lines 7-, col. 30, lines 1-19); the advertisements being based on the content that a user is receiving on said device (i.e. the advertisements are presented based on the particular game played by the user)(col. 24, lines 67-, col. 25, lines 1-10) With respect to providing a quota within a predetermined time period; determining whether the advertisements have been delivered; and terminating advertisements upon reaching the quota. Goldberg teaches determining whether the advertisement have been delivered (i.e. assuring that the advertising are indeed presented to the user)(col. 30, lines 2-14) and since the free Internet access to users is subsidized by the download of the advertisements presented to the user (col. 29, lines 7-20) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included of providing a quota within a predetermined time period and terminating advertisements upon reaching the quota because such a modification would allow to determine if the client have reached the threshold for the free Internet access.

With respect to the device being a wireless communication device and where the user will be with a predetermined of a predetermined vendor at a future time. Hall teaches processing orders from customers in a mobile environment. Determining the customer arrival time at an identified facility that can satisfy the order within a predetermined window of time coinciding with the customer's estimated time of arrival at the determined facility (col. 3, lines 55-, col. 4, lines 1-5). It would have bee obvious to

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a person of ordinary skill at the time of Applicant's invention to have included the teachings of Hall of advertisements on a wireless communication device and where the user will be with a predetermined of a predetermined vendor at a future time because such a modification would allow **"a service provider to determine the exact location, speed and direction of a mobile customer....and allows the time sequence...while customers are mobile en route to the supplier"** (see col. 2, lines 12-22).

Claim 13 further recites requiring a user to interact with the advertisements to determine whether the advertisement was reviewed. Goldberg teaches the user receiving advertisements in order to get free Internet services (col. 29, lines 7-14) further Goldberg teaches certain reliability features for assuring that the advertising is indeed presented to the user (col. 30, lines 2-14) and since the system of Goldberg is an interactive advertising system for exchanging information(col. 3, lines 66-, col. 4, lines 10-17) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure that such an advertisement was reviewed by the user.

With respect to the advertisements being based on a configuration of the wireless Device. Hall teaches that content being based on said configuration of said wireless device (col. 6, lines 66-, col. 7, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the configuration of the device because such a modification

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would allow the system to only send advertisements that correspond to the device's capabilities.

With respect to claim 5, Hall further teaches providing advertisements when end user preference corresponds with vendor criteria(i.e. based on the customer's identifying criteria and what the service provider offers(vendor) an individualized package and special tailored to meet the individual needs are presented to the customer)(col. 3, lines 55-, col. 4, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements when end user preferences corresponds with vendor criteria because such a modification would allow the system to better target the advertisements.

Claim 6 further recites requiring user interaction to determine whether an advertisement was viewed. Since Goldberg teaches that certain reliability features are included for assuring that the advertisements are presented to the user (col. 30, lines 2-5) then it would have been obvious to a person of ordinary skill in the art to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure the advertiser that the customer is entitled to the compensation.

Claims 11 and 19 recite providing advertisements at predetermined times based upon the user device habits. Since, Goldberg teaches maintaining user's preferences information such as length of time played and time played(col. 28, lines 7-

17) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a predetermined time which would be convenient to the user to receive advertisements based on the user's prior habits because such a modification would provide the advertisements at a time that would be convenient to the user.

Claim 17 further recites providing advertisements based upon advertisements acceptance. Since Goldberg teaches on col. 26, lines 16-24 that the user's responses to the advertisements are recorded then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing advertisements based on that response because such a modification would help to better target subsequent advertisements.

Claim 22 further recites conveying the determined future location of said wireless communication device to a provider of at least one product or service. Hall teaches local facilities 172, 174, 176 receiving the future location and estimated arrival time of the mobile customer in order to allow the facilities to complete the order prior to customer arrival (col. 5, lines 8-28). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Hall of conveying the determined future location of said wireless communication device to a provider of at least one product or service because such a modification would allow the facilities to complete the order prior to customer arrival.

7. Claims 7, 8, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Hall as applied to claims 1, 2, 5-6, 11-13,

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17, 19, 22 above, and further in view of Titmuss et al.(WO 98/47295 hereinafter Titmuss).

With respect to claims 7, 8, 15 and 16, Titmuss teaches that the advertisements are based upon a shopping list of said end user and shopping history of the end user (i.e. based on the customer's prior purchasing behavior and the list of things that the customer might purchase, a list of local facility and what they offer is provided to the end user (pages 14 and 19). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements that are based upon a shopping list of said end user and shopping history of the end user because such a modification would allow the system to better target the advertisements.

Response to Arguments

8. Applicant argues that Goldberg nor Hall teach terminating advertisements upon reaching a quota. The Examiner wants to point out that in the system of Goldberg teaches and also as admitted by Applicant on page 6 of the Remarks, "free Internet access to users is subsidized by advertisements". Terminating the advertisements upon reaching a quota would have been obvious in the system of Goldberg when the customer has satisfied the requirements of the ads that must be seen or heard to qualify for the free Internet services.

9. Applicant argues that the Examiner has misunderstood, the invention. In contrast, the Examiner believes that Applicant has misunderstood the Examiner's interpretation. The Examiner never stated that the Internet access is terminating upon

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reaching a quota. In contrast as stated in the rejection above, "providing a quota within a predetermined time period **and terminating advertisements upon reaching the quota** because such a modification would allow to determine if the client have reached the threshold for the free Internet access". The quota is for the advertisements and not for the Internet access.

10. Applicant argues that all the claim limitations must be taught or suggested by the prior art. The Applicant is reminded that according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. Therefore the rejection is sustained.

11. The Applicant argues that the references teach away from the invention. The Examiner disagree with Applicant. Applicant misunderstood Examiner's interpretation, as stated above.

12. With respect to arguments to claims 13 and 27, The Examiner wants to point out as stated above that according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. Therefore the rejection is sustained.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

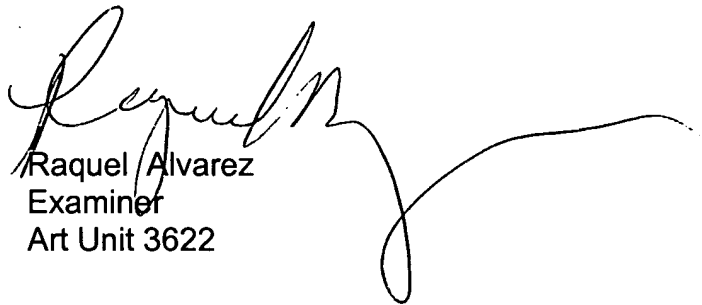
Point of contact

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Examiner
Art Unit 3622

R.A.
4/29/04